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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,897	12/09/2003	Yasuo Sugahara	1341.1164	3978
21171 7590 08/25/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
POND, ROBERT M				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
08/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,897

Applicant(s)

SUGAHARA, YASUO

Examiner

Robert M. Pond

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE(6/9/08); Amendment (5/09/08).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 June 2008 has been entered.

Response to Amendment

The Applicant amended independent claims 1, 8, 15, 17 and 18. Claims 2 and 9 were previously canceled. All pending claims 1, 3-8, and 10-18 were examined in this non-final office action following a request for continued examination.

Response to Arguments

Applicant's arguments filed 09 May 2008 have been fully considered but they are not persuasive. Arguments are based on subject matter that renders each independent claim indefinite with non-statutory subject matter, the added subject matter being hinged on mental processes that lack sufficient disclosure and guidance for examination assumptions.

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claims 1, 3- 8 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Specific to the Applicant's claims "the items being functionally related to one another" is hinged on mental processes performed by a human being whose knowledge of functionally related items varies among humans resulting in unpredictable and non-repeatable outcomes thereby rendering the claim indefinite. It is impractical for the Examiner to base examination on assumptions based on a specification lacking sufficient disclosure and guidance. Examination is based on subject previously examined. Correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 2. Claims 1, 3- 8 and 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

MPEP 2106: A claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it:

- (A) "transforms" an article or physical object to a different state or thing; or
- (B) otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

(1) Practical Application by Physical Transformation- *excerpt omitted*.

(2) Practical Application That Produces a Useful, Concrete, and Tangible Result

(2)(a) "USEFUL RESULT"

(2)(b) "TANGIBLE RESULT"

(2)(c) "CONCRETE RESULT"

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In *re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. 112, paragraph 1, where the invention cannot operate as intended without undue experimentation. See *infra*.

Subject matter added to all independent claims "the items being functionally related to one another," are per the instant specification determined by a third person who has knowledge of the functional relationships of the items. Each independent claim and dependents are hinged on a mental process. Given the lack of sufficient guidance and direction provided by the instant specification, it is determined the claimed invention does not provide a predictable, repeatable and concrete result thereby requiring undue experimentation. Please refer to MPEP at least 2164.01(a). Correction is required.

3. Claims 8, 10-14 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, a process that consists of a series of steps or acts to be performed must i) be tied to another statutory class (such as a particular apparatus) or ii) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 USC 101. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Patent statute does not allow patents to be issued on particular business systems that depend for their operation on human intelligence alone. In the present application, method claims for creating purchase information are unpatentable as directed to nonstatutory subject matter under 35 U.S.C. §101, since mental processes standing alone are not patentable, even if they have practical applications, since claims at issue do not require use of machine, and they do not describe process of manufacture or process for alteration of composition of matter, and since claims instead cover use of mental processes to create purchase information, and thus seek to patent use of human intelligence in and of itself. Correction is required.

- 4. Claims 1, 3-7, 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Units are defined by the instant specification as apparatus but sections are depicted and described as software. Software that lacks a tangible embodiment in computer-readable medium storing instructions therein and causing a computer (server) to perform one or more functions renders the claim non-statutory. Examination is based on software being embodied in a computer readable medium as noted above. Correction is required.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 5. Claims 1, 3-6, 8, and 10-13 and 15-18 are rejected under 35 USC 102(e) as being anticipated by Holland (US 6,493,742).**

Holland teaches all the limitations of claims 1, 3-6, 8, and 10-13 and 15-18. For example, Holland discloses a method of creating purchase information. See at least abstract; Fig. 1; col. 1, line 5-col. 3, line 35. Holland further discloses:

- **Regarding claim 8 and 13:** obtaining first purchase information concerning items selected by a first person from an item list provided by an online shopping service via a network; first person registers (i.e.

registrant) and creates one or more gift registries. See at least col. 2, lines 25-48.

- **Regarding claim 8 and 13:** generating purchase identification information that uniquely identifies the first purchase information and associates the unique purchase identification information with a second person; unique information obtained from a registrant; generates purchase identification information. See at least Fig. 8 (804, 806); col. 2, lines 25-48; col. 8, lines 33-col. 9, line 5.
- **Regarding claim 8 and 13:** storing the unique purchase identification; registrant information and list stored and managed in a database. See at least Fig. 1; Fig. 2; col. 4, line 15-col. 6, line 61; col. 8, line 33-col. 9, line 5.
- **Regarding claim 8:** receiving the unique purchase identification information as a search condition from the second person; guest (i.e. second person) performs search query based on registrant's name (i.e. first person). See at least Fig. 8 (802); col. 2, lines 49-65; col. 9, line 5-col. 9, line 36.
- **Regarding claim 8:** searching the storage unit for the first purchase information on the search condition; search is conducted and returns a unique identifier for each matching registry. Retrieves a matching registry. See at least Fig. 8 (804, 806); col. 2, lines 49-67; col. 9, line 5-line 36.

- **Regarding claim 8:** and creating second purchase information concerning an item to be purchased by the second person, based on the first purchase information. Guest selects one of the unique identifiers to open and review the items in the registrant's registry. The guest may pick items in the registry for purchase while the registry is open. Guest performs a single purchase transaction. See at least Fig. 8 (806 "Purchase"); Fig. 9; col. 2, line 49-col. 3, line 11; col. 9, line 5-col. 10, lines 14.
- **Regarding claims 10 and 11:** second person identification. Guest user profile using general user identifier; guest password (implied: required to access registry search and purchasing services; support for online shopping featuring unique identifiers. See at least col. 6, lines 19-38; col. 6, lines 55-61; col. 9, lines 22-36.
- **Regarding claim 12:** unique item identifier. SKU (stocked keeping unit) number or universal product code (UPC) for each item retrieve as a result of a guest search. See at least Fig. 8 (806); col. 4, lines 41-67.
- **Regarding claims 15-18:** Rejections of claims 14-18 are based on the same disclosures as noted above. See at least Figs. 1, 2, 5 and 8 for system, apparatus, and computer-readable medium containing instructions.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 7 and 14 are rejected under 35 USC 103(a) as being unpatentable over Holland (US 6,493,742).

Holland teaches all the above as noted in the 102(e) rejection and teaches a registrant desiring to establish one or more product registries accessible by one or more guests. It would have been obvious to one of ordinary skill in the art at time the invention was made to ascertain intended use of the registry (method, apparatus, and system) including a variety of users serving as registrants with peer or subordinate relationships to their guests, because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. vs. Teleflex Inc.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert M. Pond/
Primary Examiner, Art Unit 3625
August 22, 2008